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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/000,824	12/30/1997	JAYANTHA AMARASEKERA	60SI-1890	5842

7590 07/15/2004

Robert M. Schulman
Hunton & Williams
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109

EXAMINER

LU, C CAIXIA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2b45

Office Action Summary	Application No.	Applicant(s)	
	09/000,824	AMARASEKERA ET AL.	
	Examiner	Art Unit	
	Caixia Lu	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-24 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-24 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 17, 19-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants' identification of support for the instant claims are noted, however, the those identified portions of the specification as originally filed do not provide full support for the instant claims in at least two aspects: (i) the formula of the organopolysiloxane and (ii) the range of peroxide, respectively, of claim 17 . Thus, (i) and (ii) are new matter. Applicants have not yet identified the support for the formula organopolysiloxane and the full support of the entire range of peroxide is not found "at least in Examples 1 and 2" as indicated by applicants. Applicants' Examples 1 and 2 can only support two data points at most. Furthermore, applicants can not used what is "commonly known in the art" to support applicants' claims. The claimed limitation must be fully supported by the application as originally filed.

2. Claims 3-14, 17 and 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, formula I is incorrect, the R groups should be attached to Si not O.

In claims 17, component (B) is missing.

Claim Rejections - 35 USC § 102

3. Claims 1-6, 8-13, and 15-24 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsushita et al. (US 5,824,729) for the same rationale as set forth in the previous Office action mailed on January 21, 2002.

Claim Rejections - 35 USC § 103

4. Claims 7,12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushita et al. (US 5,824,729) for the same rationale as set forth in the previous Office action mailed on January 21, 2002.

5. Claims 1-17, 19-24 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dams (US 4,355,129) in view of Milbert (US 3,821,140) for the same rationale as set forth in the previous Office action mailed on January 21, 2002.

Response to Arguments

6. Applicant's arguments filed on November 4, 2003 have been fully considered.

Contrary to applicants argument that to arrive at applicants' composition based on Dams's teaching would involve a "circuitous route" of random experimentation, applicants' attention is directed to Dams' working example where all of the components of the instantly claimed composition are employed except the coupling agent. Using coupling agent to enhance the compatibility between the siloxane and filler as well as ATH are well known and routine practice in industry and coupling agents are taught in all of the cited prior art. The amount of coupling agent can be optimized though routine experimentation and such amount is likely to fall in the range of the instant claims

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considering the broader range 0.01% to 1% which is conventionally used in the industry. For example, Imahashi (US 5,583,172) teaches treating 100 parts by weight metal hydroxide surface with 0.1 to 10 parts by weight of coupling agent which encompasses the range of the instant claims.

Applicants also argue that Dams does not disclose a processing fluid which is a polysiloxane oil. During the mixing of the components of a curable composition for preparation of a cured siloxane composition, it is a routine practice to add some siloxane process oil to help the mixing of the components and siloxane process oil is used in Milbert's Example 1 such as α,ω -dihydroxyl-dimethylpolysiloxane (col. 4, lines 25-27 and 45-46). Thus, it would have been obvious to for skilled artisan to add Milbert's process fluid to Dams composition to make mixing of the components easier. The limitations of all claims have been considered and are deemed to be within the purview of the prior art and, thus, the rejections are maintained.

Applicants assert that the examiner indicated the canceled limitation, "wherein said coupling agent (c) is present in an amount effective to act as a surface as a surface modifier" in claim 1, is not necessary for patentability in light of the cited art. There is no Office record for such assertion. Applicants are advised to stop forcing opinions on the examiner. This is the second time applicants have done so during the prosecution.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

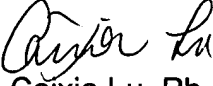
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicants' second request for an interference is noted, however, will not be considered due to the outstanding rejections of the record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caixia Lu whose telephone number is (571) 272-1106. The examiner can normally be reached from 9:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful and the matter is urgent, the examiner's supervisor, David Wu, can be reached at (571) 272-1114. The fax numbers for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1700.


Caixia Lu, Ph. D.
Primary Examiner
June 30, 2004